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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,228	09/13/1999	GLENN PETKOVSEK	P-99-012	3917

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/30/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,228

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-23 is/are allowed.
- 6) ☒ Claim(s) 1-12, 24-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1 and 9 have been amended for further examination. Claims 24-26 have been added.

Claim Rejections - 35 USC § 112

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 discloses a mailing assembly comprising a label "wherein the front side and the back side of the label include shading and printing". These limitations are not disclosed in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7-9, and 11, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabel (5,836,622).

Fabel discloses in Fig. 13, a mailing assembly and a method of preparing a mail piece comprising: a label (72) having a front side (74) and a backside (75); includes a return postcard (86, which includes upper section (146) and lower section (144)), having printed information relating to delivery of the mail piece, formed with a designator section (158) indicative of a special service wherein the designator section is contained within the exterior sides (lines 184) that defines the return postcard (86) and further contains a machine readable code (Col. 10, lines

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36-43); and further wherein the label (72) includes shading and printing, wherein the shading and printing on the label are a single color (Col. 9, lines 26-33, wherein the information indicia is “printed in a green color”; and in Col. 10, lines 20-26, wherein the return receipt has a background color “using the same used to pre-print information on sender’s receipt section”). Fabel further discloses a first and second anchor portion (tabs 177) being removably attached to the post card through the use of perforated lines (184), wherein the first anchor portion has an adhesive (76, as seen in Fig. 14) on a backside (seen in Fig. 14) of the first anchor portion; and wherein a backing strip (178) is disposed of the adhesive (76) on the backside of the first and second anchor portion.

However, Fabel does not disclose wherein the front side and the back side of the label include shading and printing.

In regards to Claim 1, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the shading and printing at any location on the label, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Therefore, it would be obvious to place the shading and printing at any desired location since applicant has not stated why it would be critical to place the shading and printing at a particular location or side.

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3. Claims 1-3, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725) in view of Schwan et al (5,524,934).

Walz discloses in Fig. 1, 4 and 5, a mailing assembly and a method of preparing a mailpiece comprising a label (10) having a front side (Fig. 1) and a backside (Fig. 5) wherein the label (10) includes a postcard (which is the area (A) defined between perforated lines 24 and 26, Col. 4, lines 40-53) and an integrally formed designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5); and wherein the backside includes indicia (Col. 4, lines 40-58).

However, Walz does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color.

Schwan et al discloses in Fig. 2, 3 and 5, a record in the form of a label (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and 4). The coatings (color formers and color developers) can be applied in selected areas on the label, and when combined can form blocks of background color(s) or may be applied so as to form symbols or indicia (Col. 4, lines 58-61 and Claims 1-3), both in many different shades or hues (Col. 4, lines 14-20).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's label to include a label having self contained coatings to form a shading and printing of a particular color as set forth by Schwan et al for the purpose of providing an advantage that both information and colored areas on a document can be achieved by printing in a single pass through a thermal or impact printer and further wherein the colored label can be used as an indication of where the label and its accompanying contents are to be routed.

In regards to **Claims 9 and 11**, the method for preparing a mail piece for delivery by providing a label having a front side and a back side, wherein the label includes a postcard and an integrally formed designator section that is contained within exterior sides that defines the return postcard; providing one anchor on an exterior side of the postcard, wherein the anchor portion has a backside, and further wherein the backside includes adhesive. Furthermore, Walz teaches the method step of removing a backing strip (49) disposed over the adhesive (as seen in Fig. 5); an attaching the label to a mail piece (Col. 4, lines 63-67 and Col. 5, lines 1-3); and printing information on the return postcard relating to delivery of the mail piece by a special service (Col. 4, lines 35-53).

Furthermore in regards to **Claim 9**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the shading and printing at any location on the label, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Therefore, it would be obvious to place the shading and

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printing at any desired location since applicant has not stated why it would be critical to place the shading and printing at a particular location or side.

In regards to **Claim 1, 7, 9 and 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Even further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

4. Claims 4-6, 10, 12, and 24-26, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walz in view of Schwan et al, and further in view of Petkovsek (5,697,648).

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Walz as modified Schwan et al discloses a mailing assembly and method of preparing a mail piece comprising all the elements as set forth in Claims 1 and 9, and as set forth above. Walz also discloses an associated backing sheet (14) attached to the backing strips (49) and the postcard (70).

However, Walz does not disclose a printer track strip associated (Webster Dictionary defines as “combined”) extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor portion.

Petkovsek discloses in Fig. 5, a mailing assembly having a label sheet (11) having a width between a first end (E1) and a second end (E2); wherein the first end has a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) at one end of the assembly (E1) and is removably attached to the anchor portion (28)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz’s and Schwan et al’s mailing assembly by replacing the backing strip associated with the assembly with a backing strip containing a printer track strip as taught by Petkovsek for the purpose of allowing the mailing assembly to be passed through a printer.

Note, the examiner also submits that the patent reference (Petkovsek) is considered prior art because it had issued more than one year prior to the actual filing date (9/13/99) of the application and application claims 4 and 12 recite subject matter not supported by the parent patent

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(Petkovsek). Therefore, the claims are not entitled to a date earlier than the actual filing date of this application. See MPEP 2133.01.

Allowable Subject Matter

5. Claims 13-23 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly suggests a mailing assembly comprising a plurality of labels removably attached and includes a postcard, a designator section, and a printer track strip associated with each label wherein the printer tracking strip includes a first hole and each label has a second hole.

Response to Arguments

7. Applicant's arguments filed on October 16, 2003 have been fully considered but they are not persuasive.

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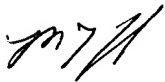
In regards to Claims 5, 6 and 10 being allowable subject matter, the examiner submits that Claims 5, 6 and 10 are now rejected under Walz in view of Petkovsek.

In regards to applicant's argument that Claims 1 and 9 do not disclose wherein "the label has a front side and a back side that includes shading and printing", the examiner submits that it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the shading and printing at any location on the label, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Therefore, it would be obvious to place the shading and printing at any desired location since applicant has not disclosed why it would be critical to place the shading and printing at a particular location or side.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

December 26, 2003



Daniel W. Howell
Primary Examiner
Art Unit 3722